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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/930,235 | 02/23/1998 | ANJA EITRICH | BEIERSDORF45 | 2748 |
| 7055 | 7590 | 12/14/2006 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | METZMAIER, DANIEL S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |
| DATE MAILED: 12/14/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26 and 32-37 is/are rejected.
- 7) ☒ Claim(s) 38-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims 12-17, 19-20, 23-24, 26, and 32-40 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "obtainable" renders the claim indefinite since it is unclear whether the composition that has been obtained is being claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-13, 17, 32-34, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by McGee et al, US 5,585,343. McGee et al (examples and claim 4) disclose Low VOC perfume formulations as microemulsions..

McGee et al (claim 4) discloses sodium laureth sulfate, which is a sodium lauryl ether sulfate as instantly disclosed as the polyethoxylated emulsifiers.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 12-17, 19-20, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al, US 5,585,343. McGee et al (examples and claim 4) disclose Low VOC perfume formulations as microemulsions..

McGee et al (claim 4) discloses sodium laureth sulfate, which is a sodium lauryl ether sulfate as instantly disclosed as the polyethoxylated emulsifiers.

McGee et al differs from the claims in the further addition of cosmetic additives to said compositions.

McGee et al (column 7, lines 40-46) discloses cosmetic additives reading on those claimed as commonly added formulating ingredients. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ a conventional additive as taught in the McGee et al reference for their art recognized advantageous functions.

9. Claims 12, 16-17, 20, 23-24, 26, 20-33 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henkel KGaA, DE 4,010,393, (especially Beispiele 1-2, Tabelle 1, and abstract) as evidenced by Schambil et al, US 6,086,787.

Schambil et al is an English language family member of Henkel KGaA as shown by the foreign priority document of Schambil et al, which is the Henkel KGaA application. All remaining citations will refer to the Schambil et al reference hereafter.

Henkel KGaA and Schambil et al (column 1) discloses several prior art cosmetic emulsions as cosmetic creams. The Henkel KGaA and Schambil et al invention is directed to processes of making said emulsions having improved properties.

Henkel KGaA and Schambil et al (column 3-4, lines 66-11) state that their microemulsions are transparent or translucent. This property would appear to be inherent in the patentees' microemulsions.

Furthermore, Henkel KGaA and Schambil et al (column 1, lines 23-31) disclose prior art transparent and bluish opalescence (transluscent) as microemulsions. Henkel KGaA and (column 2, lines 4 et seq) disclose the emulsions are formed by phase inversion and are characterized by particularly high particle fineness and stability. Said characterization are known to transparent and translucent microemulsions.

Henkel KGaA and Schambil et al (Table 1 and column 3, lines 52 et seq) disclose the use of glycerol esters of stearic or oleic acids among others. Henkel KGaA and Schambil et al (Table II and column 4, lines 53 et seq) disclose suitable thickeners. Henkel KGaA and Schambil et al (column 4, lines 46 et seq) discloses said glycerol esters are lipophilic consistency generators and would likewise function as the broadly claimed moisture retaining substances.

10. Claims 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel KGaA, DE 4,010,393, (especially Beispiele 1-2, Tabelle 1, and abstract) in view of Schambil et al, US 6,086,787, Rosano, US 4,146,499. Henkel KGaA and Schambil et al discloses microemulsions as set forth in the above rejection. Said basis is incorporated herein by reference.

Henkel KGaA and Schambil et al differs from the claims in the incorporation of conventional cosmetic ingredients.

Rosano (abstract and column 1, lines 6 et seq) discloses transparent microemulsions and methods of making said microemulsions. Rosano (column 5, lines 11 et seq) discloses the microemulsions may include materials for hair conditioning and skin emollients for use in shampoos, shaving creams and hand soaps. Shaving creams

are well known to contain astringents. Rosano (column 5, lines 41 et seq) further discloses the incorporation of organic solvents as conventional ingredients. Rosano (column 9, lines 6-24) discloses the conventional use of at least perfumes or dyestuff in said microemulsions.

These references are combinable since said references teach transparent (i.e., clear) microemulsions having cosmetic use. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ conventional cosmetic ingredients shown and/or implicit in the Rosano reference for their advantageous intended function known to those having ordinary skill in the cosmetic art.

Allowable Subject Matter

11. Claim 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive.

13. Applicants (pages 10 and 11) assert the since the Henkel and Schambil references are creams or ointments. This has not been deemed persuasive since at least claim 12 reads on the microemulsions disclosed in the Henkel and Schambil references for use in cosmetics. Furthermore, the final cosmetic product is thickened. A thickened microemulsion does not necessarily become non-transparent or non-

translucent. Furthermore, the reference does not characterize the microemulsion as having been destroyed.

Lastly, the compositions of the Henkel and Schambil references employ the same additives as those instantly disclosed.

14. Applicants assert the Henkel and Schambil references do not disclose any specific utility such as hair or skin care compositions. The Henkel and Schambil references specifically mention the properties of dermatological compatability and skin feel for cosmetics.

15. Applicants (page 14) assert that Henkel and Schambil references are not cured by the Rosano reference. The arguments regarding the Henkel and Schambil references have been addressed above.

16. Applicant's arguments with respect to claims 36-37 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM